

Applicants: Mark Ledebot et al.
Application No.: 10/005,133

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AUG 03 2006

REMARKS

The Claim Amendments

Applicants have amended claims 1-3 to delete the recitation of "hydrogen" for variable R¹ and have further amended claim 1 to delete the recitation of "hydrogen" for variable R³.

None of these amendments adds new matter. Their entry is requested.

Applicants reserve the right to pursue the canceled subject matter in this application or in future continuing or divisional applications.

The Response

The Rejections Under 35 U.S.C. §112, Second Paragraph

The Examiner states that claims 4-6 are rejected under 35 U.S.C. §112, second paragraph for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Specifically, the Examiner states that claims 4 and 5 lack antecedent basis because R¹ can be cyclohexyl, which is not encompassed by T_(n)-Ar¹ in claim 1. Similarly, the Examiner states that claim 6 lacks antecedent basis because it recites species wherein R¹ is a cyclohexyl group. Applicants traverse.

Claim 1 recites that R¹ can be T_(n)-R, wherein R is an aliphatic or substituted aliphatic group. The specification clearly states that an aliphatic group includes cyclic C₁-C₁₂ hydrocarbons. See page 9, lines 9-13 of the specification. Thus, originally-filed claim 1 encompassed cyclic aliphatic groups such as cyclohexyl.

Double Patenting

The Examiner has rejected claims 1-5, 17, 20 and 21 under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-3, 5 and 12 of United States Patent 6,884,804 B2.

Applicants stand ready to provide a terminal disclaimer upon notice of allowable subject matter.

The Rejections Under 35 U.S.C. §103(a)

The Examiner has rejected claims 1 and 17 under 35 U.S.C. §103(a) as allegedly being unpatentable over United States Patent 6,514,977 B1 (hereafter the '977 patent).

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The Examiner has also rejected claims 1 and 17 under 35 U.S.C. §103(a) as allegedly being unpatentable over WO 98/52940 (hereafter the '940 application). Specifically, the Examiner states that Scheme C-11 of the '977 patent and Scheme C-4 of the '940 application describe a process for making a 2-substituted pyrimidinylpyrazole wherein R¹ is hydrogen; R² is R, which is an aliphatic group substituted with NH₂ or R is -CH₂NH₂; G is hydrogen or alkyl; and R³ is hydrogen.

As amended, neither R¹ nor R³ can be hydrogen in the instantly-claimed genus. Neither the '977 patent nor the '940 application teach or suggest compounds in which R¹ and R³ are other than hydrogen, thus obviating this rejection.

Conclusion

Applicants request that the Examiner enter the above amendments, consider the accompanying arguments, and allow the claims to pass to issue. Should the Examiner deem expedient a telephone discussion to further the prosecution of the above application, applicants request that the Examiner contact the undersigned at his convenience.

Respectfully submitted,

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